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| EXAMINER | | | | |
| SELLS, JAMES D | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1791 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-Legal.PRC@usa.dupont.com

Office Action Summary

Application No.

10/759,814

Applicant(s)

HACKLER ET AL.

Examiner

James Sells

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-43 and 45-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-43 and 45-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of the appeal brief filed on May 27, 2008, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Philip C Tucker/

Supervisory Patent Examiner, Art Unit 1791

Allowable Subject Matter

2. The indicated allowability of claims 49-51, 67-73 (objected) and 77 (allowed) is withdrawn in view of the newly discovered reference(s) to Kurotori et al (US Patent 4,415,533) and Yamamoto et al (US Patent 5,047,798). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 31-43, and 52-53, 56-61, 63 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (WO 01/18604) in view of Kurotori et al (US Patent 4,415,533).

Regarding claim 31, Johnson discloses a method and apparatus for thermal processing a photosensitive element. As shown in Fig. 15, the system comprises photosensitive sheet 16, which is fed onto drum 18. Heater 300 heats the sheet in the manner claimed by the applicant. Plate processor 10a includes a delivery means for feeding continuous absorbent web 76 of non-woven material, which contacts the hot roller. Blower 356 and shroud 358 extend around drum in close proximity to surface 22.

Vacuum fan unit 368 forms a plenum with underpart of conveyor 144a to control fumes from heating the composition later on sheet 16. The exhaust from unit 368 is vented through conduit 370. See page 28, line 13 through page 35, line 3.

However, Johnson does not disclose the means for collecting the vapor at the means for supplying as claimed by the applicant. Regarding this difference, the applicant is directed to the reference of Kurotori.

Kurotori discloses an apparatus for treating exhaust gases. As shown in Fig. 3, the apparatus comprises suction pump 7, heat fixing rollers 10 and covers 24, 25 and 26. Solvent vapor generated from the heat fixing operation is sucked via suction pump 7 to remove such vapors from within the apparatus. See col. 5, lines 1-5, 46-67 and col. 6, lines 1-7.

It would have been obvious to one having ordinary skill in the art to position a vapor suction/removal system at the place where they are generated in the apparatus of Johnson (i.e. at the means for supplying the absorbent material) in order to provide the predictable result of more quickly removing harmful vapors to prevent contamination and corrosion of the inner mechanisms of the apparatus. Such a configuration appears to be a merely mechanical modification and is therefore an obvious expedient over the configuration disclosed by Johnson. The court has held that a mere change in the arrangement or location of mechanical elements represents an obvious expedient and that mechanical equivalents would be merely a matter of choice for one having ordinary skill in the art. See *In re Gazda*, 104 USPQ 400 (CCPA 1955).

The applicant is also reminded that the materials used are not germane to the patentability of an apparatus claim.

Regarding claim 32, Johnson discloses means for means for supporting the photosensitive element, wherein at least one of the means for supplying and the means for supporting are movable relative to the other (hot roller 78 movable in direction 315); and means for contacting the photosensitive element with the absorbent material (via arms 312 and 314 which function as a moveable frame 102) to allow at least a portion of the liquefied material of the composition layer to be absorbed by the absorbent material.

Regarding claim 33, Johnson discloses means for separating the photosensitive element from the absorbent material (shown in Figs. 6 and 15).

Regarding claim 34, Johnson discloses means for supplying comprises a roller mounted for rotation in a first frame portion (absorbent web 76 supplied from roll 96, fed over hot roller 78 and collected on take-up roll 80).

Regarding claim 35, Johnson discloses means for supporting comprises a drum (drum 18) mounted for rotation in a second frame portion, the drum having an outer circumferential surface adapted to support the photosensitive element.

Regarding claim 36, Johnson discloses heating means (heater 300) for heating the absorbent material and photosensitive material in the manner claimed by the applicant.

Regarding claim 37, Kurotori discloses cover elements 24 and 25 which confine the vapor.

Regarding claim 38, Kurotori discloses suction pump 7 for managing removal of the vapor.

Regarding claim 39, Kurotori discloses suction pump 7 for exhausting the vapor.

Regarding claim 40, Kurotori shows suction pump 7 as an external exhaust collection system. See Fig. 3 of Kurotori.

Regarding claim 41, Kurotori shows suction pump 7 as a means for maintaining non-recirculating flow of the vapor.

Regarding claim 42, Kurotori shows heaters 3 which maintain the vapor at a temperature sufficient to keep the vapor in its vaporized state for removal.

Regarding claim 43, Johnson discloses cooling means 355 which functions to cooling the vapor to a temperature sufficient to condense one or more of the components.

Regarding claim 52, Kurotori discloses suction pump 7 for exhausting the vapor.

Regarding claim 53, Kurotori shows suction pump 7 as a means for maintaining non-recirculating flow of the vapor.

Regarding claim 56, heater 300 of Johnson is a heating station.

Regarding claim 57, the catalyst bed 4 of Kurotori functions as a manifold.

Regarding claim 58, Kurotori discloses suction pump 7 for exhausting the vapor.

Regarding claim 59, Kurotori discloses cover elements 24 and 25 which shroud the vapor.

Regarding claim 60, Johnson discloses cooling means 355 which functions to remove the heated air in the manner claimed by the applicant.

Regarding claim 61, Johnson discloses a controller for controlling the power to heater 300.

Regarding claim 63, Kurotori discloses cover elements 24 and 25 which direct the vapor in the manner claimed by the applicant.

Regarding claim 74, Johnson shows collecting the vapor at or adjacent the nip of rollers 10. See Fig. 3 of Johnson.

Regarding claims 31-43, and 52-53, 56-61, 63 and 74, the claims have been treated as means plus function claims under 35 U.S.C. 112, 6th paragraph and examined according to procedures followed for means plus function claims.

5. Claims 45-48 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (WO 01/18604) in view of Kurotori as described above in paragraph 4 in further view of applicant's admitted prior art.

Regarding claims 45-48, On page 3, lines 11-22 of specification, applicant discloses a commercial embodiment which employs a collection pan to collect condensate. Such a collection pan constitutes a means for confining the condensate, means for managing removal of the condensate and means for collecting the condensate in the manner claimed by the applicant.

It would have been obvious to one having ordinary skill in the art to employ such a collection pan in the device of Johnson as described above in order to prevent such condensate from damaging the system.

Regarding claim 76, Johnson discloses a method and apparatus for thermal processing a photosensitive element. As shown in Fig. 15, the system comprises means for heating (heater 300) the exterior surface of the composition layer to a temperature sufficient to cause a portion of the layer to liquefy and cause one or more components in the layer to form a vapor and means for collecting the vapor (blower 356 and shroud 358 extending around drum in close proximity to surface 22 with vacuum fan unit 368 venting exhaust through conduit 370). See page 28, line 13 through page 35, line 3.

However, Johnson does not disclose the means for collecting the vapor at the means for supplying as claimed by the applicant. Regarding this difference, the applicant is directed to the reference of Kurotori.

Kurotori discloses an apparatus for treating exhaust gases. As shown in Fig. 3, the apparatus comprises suction pump 7, heat fixing rollers 10 and covers 24, 25 and 26. Solvent vapor generated from the heat fixing operation is sucked via suction pump 7 to remove such vapors from within the apparatus. See col. 5, lines 1-5, 46-67 and col. 6, lines 1-7.

It would have been obvious to one having ordinary skill in the art to position a vapor suction/removal system at the place where they are generated in the apparatus of Johnson (i.e. at the means for supplying the absorbent material) in order to provide the predictable result of more quickly removing harmful vapors to prevent contamination and corrosion of the inner mechanisms of the apparatus. Such a configuration appears to be a merely mechanical modification and is therefore an obvious expedient over the

configuration disclosed by Johnson. The court has held that a mere change in the arrangement or location of mechanical elements represents an obvious expedient and that mechanical equivalents would be merely a matter of choice for one having ordinary skill in the art. *See In re Gazda*, 104 USPQ 400 (CCPA 1955).

The applicant is also reminded that the materials used are not germane to the patentability of an apparatus claim.

However, Johnson does not disclose the means for confining the collected condensate. Regarding this difference, the applicant is directed to the admitted prior art. On page 3, lines 11-22 of specification, applicant discloses a commercial embodiment which employs a collection pan to collect condensate. Such a collection pan constitutes a means for collecting the condensate in the manner claimed by the applicant. In addition, such systems typically employ piping or tubing with vertically oriented regions, thus employing gravity to facilitate transport of the condensate.

It would have been obvious to one having ordinary skill in the art to employ such a collection pan with vertically oriented piping or tubing in the device of Johnson as described above in order to prevent such condensate from pooling and damaging or corroding the system.

Regarding claims 45-48 and 76, the claims have been treated as means plus function claims under 35 U.S.C. 112, 6th paragraph and examined according to procedures followed for means plus function claims.

6. Claims 49-51, 54-55, 62, 64-73, 75 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (WO 01/18604) in view of Kurotori as described above in paragraph 4 in further view of Yamamoto et al (US Patent 5,047,798).

Regarding claim 49-50, Yamamoto discloses fan 45 which transports the gases through filter 45 having one or more paper or condensate absorbent materials. It would have been obvious to one having ordinary skill in the art to employ a filter with one or more paper or condensate absorbent materials, as taught by Yamamoto, in the apparatus of Johnson, in order to provide the predictable result of separating harmful or undesirable gasses from the exhaust.

Regarding claim 51, it is well known in the art to employ actinic radiation to polymerize or harden materials. See applicant's specification at page 1, line 29 through page 2, line 9. It would have been obvious to one having ordinary skill in the art to employ actinic radiation to polymerize or harden the condensate in order to provide the predictable result of facilitating handling and disposal of the condensate waste material in the device of Johnson.

Regarding claim 54, Yamamoto discloses a filter 45 which functions as a separation unit to separate harmful or undesirable gasses from the exhaust. This filter 45 includes one or more paper layers (i.e. condensate absorbent material).

Regarding claim 55, fan 45 of Yamamoto transports the gases through filter 45 having one or more paper or condensate absorbent materials.

Regarding claim 62, Yamamoto discloses a gas purification system for a thermal fixing machine. As shown in Fig. 3, the purification system comprises fan 43 which supplies air at the means for collecting exhaust gasses. It would have been obvious to one having ordinary skill in the art to employ a fan as taught by Yamamoto, as the suction pump of Kurotori as combined with Johnson in order to provide the predictable result of transporting exhaust gasses as needed.

Regarding claim 64, the fan of Yamamoto pressurizes the air in the manner claimed by the applicant.

Regarding claim 65, Fig. 1 of Yamamoto shows support frame 42 for venting fan 43 which vents the filtered gasses into the air surrounding the machine 1. Thus air exhausted from the apparatus can be used in the means for supplying air in the manner claimed by the applicant.

Regarding claim 66, Yamamoto discloses a filter 45 which functions as a separation unit to separate harmful or undesirable gases from the exhaust.

Regarding claims 67-69 and 71-73, many different separation units for separating condensate from vapor are well known and commercially available. Such conventional separation units include coalescing units, impingement surfaces, media for collecting and draining and cyclone separators. It would have been obvious to one having ordinary skill in the art to employ these various separation units in the apparatus of Johnson in order to provide the predictable result of separating the condensate from the vapor based on the physical and chemical requirements of the materials being separated.

Regarding claim 70, Yamamoto discloses a filter 45 which functions as a separation unit to separate harmful or undesirable gases from the exhaust.

Regarding claim 75, Johnson discloses a method and apparatus for thermal processing a photosensitive element. As shown in Fig. 15, the system comprises means for heating (heater 300) the exterior surface of the composition layer to a temperature sufficient to cause a portion of the layer to liquefy and cause one or more components in the layer to form a vapor and means for collecting the vapor (blower 356 and shroud 358 extending around drum in close proximity to surface 22 with vacuum fan unit 368 venting exhaust through conduit 370). See page 28, line 13 through page 35, line 3.

However, Johnson does not disclose the means for collecting the vapor at the means for supplying as claimed by the applicant. Regarding this difference, the applicant is directed to the reference of Kurotori.

Kurotori discloses an apparatus for treating exhaust gases. As shown in Fig. 3, the apparatus comprises suction pump 7, heat fixing rollers 10 and covers 24, 25 and 26. Solvent vapor generated from the heat fixing operation is sucked via suction pump 7 to remove such vapors from within the apparatus. See col. 5, lines 1-5, 46-67 and col. 6, lines 1-7.

It would have been obvious to one having ordinary skill in the art to position a vapor suction/removal system at the place where they are generated in the apparatus of Johnson (i.e. at the means for supplying the absorbent material) in order to provide the predictable result of more quickly removing harmful vapors to prevent contamination

and corrosion of the inner mechanisms of the apparatus. Such a configuration appears to be a merely mechanical modification and is therefore an obvious expedient over the configuration disclosed by Johnson. The court has held that a mere change in the arrangement or location of mechanical elements represents an obvious expedient and that mechanical equivalents would be merely a matter of choice for one having ordinary skill in the art. *See In re Gazda*, 104 USPQ 400 (CCPA 1955).

The applicant is also reminded that the materials used are not germane to the patentability of an apparatus claim.

However, Johnson does not disclose the separation unit as claimed by the applicant. Regarding this difference, the applicant is directed to the reference of Yamamoto.

Yamamoto discloses a filter 45 which functions as a separation unit to separate harmful or undesirable gasses from the exhaust. This filter 45 includes one or more paper layers (i.e. condensate absorbent material). It would have been obvious to one having ordinary skill in the art to employ a filter with one or more paper or condensate absorbent materials, as taught by Yamamoto, in the apparatus of Johnson, in order to provide the predictable result of separating harmful or undesirable gasses from the exhaust.

Regarding claim 77, Johnson discloses a method and apparatus for thermal processing a photosensitive element. As shown in Fig. 15, the system comprises means for heating (heater 300) the exterior surface of the composition layer to a temperature sufficient to cause a portion of the layer to liquefy and cause one or more

components in the layer to form a vapor and means for collecting the vapor (blower 356 and shroud 358 extending around drum in close proximity to surface 22 with vacuum fan unit 368 venting exhaust through conduit 370). Heater 300 and blower 356 function to maintain the collected vapor in a vaporized state. See page 28, line 13 through page 35, line 3.

However, Johnson does not disclose the means for collecting the vapor at the means for supplying as claimed by the applicant. Regarding this difference, the applicant is directed to the reference of Kurotori.

Kurotori discloses an apparatus for treating exhaust gases. As shown in Fig. 3, the apparatus comprises suction pump 7, heat fixing rollers 10 and covers 24, 25 and 26. Solvent vapor generated from the heat fixing operation is sucked via suction pump 7 to remove such vapors from within the apparatus. See col. 5, lines 1-5, 46-67 and col. 6, lines 1-7.

It would have been obvious to one having ordinary skill in the art to position a vapor suction/removal system at the place where they are generated in the apparatus of Johnson (i.e. at the means for supplying the absorbent material) in order to provide the predictable result of more quickly removing harmful vapors to prevent contamination and corrosion of the inner mechanisms of the apparatus. Such a configuration appears to be a merely mechanical modification and is therefore an obvious expedient over the configuration disclosed by Johnson. The court has held that a mere change in the arrangement or location of mechanical elements represents an obvious expedient and

that mechanical equivalents would be merely a matter of choice for one having ordinary skill in the art. *See In re Gazda*, 104 USPQ 400 (CCPA 1955).

The applicant is also reminded that the materials used are not germane to the patentability of an apparatus claim.

However, Johnson does not disclose the filter as claimed by the applicant. Regarding this difference, the applicant is directed to the reference of Yamamoto.

Yamamoto discloses a filter 45 which functions as a separation unit to separate harmful or undesirable gasses from the exhaust. This filter 45 includes one or more paper layers (i.e. condensate absorbent material). It would have been obvious to one having ordinary skill in the art to employ a filter with one or more paper or condensate absorbent materials, as taught by Yamamoto, in the apparatus of Johnson, in order to provide the predictable result of separating harmful or undesirable gasses from the exhaust.

Regarding claims 49-51, 54-55, 62, 64-73, 75 and 77, the claims have been treated as means plus function claims under 35 U.S.C. 112, 6th paragraph and examined according to procedures followed for means plus function claims.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 49 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 49 recites the vapor forms a condensate and the condensate is delivered to the absorbent material. However, the only absorbent material recited in claim 31 is the absorbent material supplied to the exterior surface of the composition layer. This is different than the condensate absorbent material recited in following claims.

Response to Arguments

9. Applicant's arguments filed 05/27/2008 have been fully considered but they are not persuasive.

Applicant argues Johnson does not contemplate any problems with vapor forming condensate throughout the apparatus and does not suggest structural elements to handle the condensate formed from the vapor. Claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Since Johnson's apparatus appears to have the same structure as applicant's claimed invention, it is the examiner's position that the disclosure of Johnson makes obvious applicant's claims under 35 USC 103. Therefore applicant's argument is believed to be incorrect in this instance.

In response to applicant's argument that Johnson does not contemplate any problems with vapor forming condensate throughout the apparatus and does not

suggest structural elements to handle the condensate formed from the vapor, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicant argues there is no motivation to one of ordinary skill in the art to make a change in the arrangement or location of mechanical elements. The examiner does not agree. As stated above, the court has held that a mere change in the arrangement or location of mechanical elements represents an obvious expedient and that mechanical equivalents would be merely a matter of choice for one having ordinary skill in the art. See *In re Gazda*, 104 USPQ 400 (CCPA 1955). Therefore applicant's argument is believed to be incorrect in this instance.

The rest of applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Telephone/Fax

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sells whose telephone number is (571) 272-1237. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Phil Tucker can be reached on (571) 272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Sells/
Primary Examiner, Art Unit 1791